

RECEIVED  
CENTRAL FAX CENTER

NOV 22 2006

**Response under 37 C.F.R. 1.116**

Applicant: Travis J. Parry

Serial No.: 09/989,340

Filed: November 20, 2001

Docket No.: 10012807-1

Title: METHOD AND SYSTEM FOR DISTRIBUTING PRINT JOB**REMARKS**

The following Remarks are made in response to the Final Office Action mailed November 1, 2006, in which claims 1-17 and 19-21 were rejected.

Claims 1-17 and 19-21 remain pending in the application and are presented for reconsideration and allowance.

**Claim Rejections under 35 U.S.C. § 103**

Claims 1-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Czyszczewski et al. US Patent No. 6,577,907 in view of Chang et al. US Publication No. 2002/0055984.

Applicant respectfully traverses this rejection.

The method of independent claim 1 recites that the e-mail enabled printer is capable of creating and sending e-mails, and includes "attaching said print job data to an e-mail created by said e-mail enabled printer," and "sending said e-mail and said print job data from said e-mail enabled printer to an e-mail enabled device."

The method of independent claim 11 recites that the e-mail enabled printer is capable of creating and sending e-mails, and includes "creating an e-mail with said e-mail enabled printer," and "sending said e-mail from said e-mail enabled printer for distributing said data of said selected at least one print job."

The system of independent claim 16 recites that the e-mail enabled printer is capable of creating and sending e-mails, and provides that the at least one microprocessor of the e-mail enabled printer "is configured to translate said data of said print job into an image format for printing by said e-mail enabled printer, and is configured to create an e-mail, attach said data of said print job to said e-mail, and send said e-mail and said data of said print job to an e-mail enabled device."

The method of independent claim 21 includes "connecting said e-mail enabled printer to a network," "retrieving said print job data from a memory of said e-mail enabled printer using a network device in communication with said e-mail enabled printer via said network," "attaching said print job data to an e-mail," and "sending said e-mail and said print job data from said e-mail enabled printer to an e-mail enabled device."

**Response under 37 C.F.R. 1.116**

Applicant: Travis J. Parry

Serial No.: 09/989,340

Filed: November 20, 2001

Docket No.: 10012807-1

Title: METHOD AND SYSTEM FOR DISTRIBUTING PRINT JOB

The Examiner contends that the Czyszczewski et al. patent discloses a method of distributing print job data from an e-mail enable printer, with said print job data to be printed by the e-mail enabled printer and said e-mail enabled printer capable of creating and sending e-mails, with said method comprising: retrieving said print job data from a memory of said e-mail enable printer; attaching said print job data to an e-mail created by said e-mail enabled printer; sending said e-mail and said print job data from said e-mail enabled printer to an e-mail enable device; and storing said print job data in a job retention memory of said e-mail enabled device (see, e.g., Detailed Action, pages 2-3).

The Examiner recognizes, however, that the Czyszczewski et al. patent does not disclose a printer and the recited elements that are part of the printer (see, e.g., Detailed Action, page 3). As such, the Examiner contends that the Chang et al. publication discloses in Figs. 4a to 4c that a printer controller can reside inside the printer as shown in Fig. 4c (see, e.g., Detailed Action, page 3). Thus, the Examiner suggests that, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the integration of the printer controller unit as taught by Chang with the printers of Czyszczewski (see, e.g., Detailed Action, page 3).

The Czyszczewski et al. patent discloses a multifunction device 10 including a multifunction controller 25, a first interface 120 for receiving input data from at least one scanner 20 and a second interface 125 for outputting processed input data to at least one printer 43 (see Abstract; Figs. 1, 2, and 5). In addition, the Czyszczewski et al. patent discloses that the multifunction controller 25 is capable of communicating with, and utilizing, various optional global services 55 and optional local services 135 including e-mail, facsimile (fax), printer, directory, security and library services and datastores (col. 5, lines 15-24).

As such, the Czyszczewski et al. patent suggests that the multifunction controller 25 enables a user to send the same document to a number of printers, fax numbers, and e-mail addresses, and provides a user with an ability to request printing, to hold a document for later access, as well as to redirect a document to a desired printer or other output device (col. 3, lines 2-7). Thus, the Czyszczewski et al. patent teaches that the multifunction controller 25 implements the optional global services 55 or optional local services 135 including e-mailing from the multifunction device 10. The Czyszczewski et al. patent, however, does not teach or

**Response under 37 C.F.R. 1.116**

Applicant: Travis J. Parry

Serial No.: 09/989,340

Filed: November 20, 2001

Docket No.: 10012807-1

Title: METHOD AND SYSTEM FOR DISTRIBUTING PRINT JOB

suggest that printer 43 (or global remote printers 53) perform the optional global services 55 or optional local services 135 such as e-mailing.

The Examiner suggests that it would have been obvious to a person of ordinary skill in the art to integrate the controller with the printer. Applicant notes that the Czyszczewski et al. patent actually teaches away from incorporating multifunction controller 25 into printer 43. In addition, Applicant submits that modifying the Czyszczewski et al. patent to incorporate multifunction controller 25 into printer 43, as suggested by the Examiner, would render the Czyszczewski et al. patent unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Thus, Applicant submits that modifying the Czyszczewski et al. patent to integrate the controller with the printer, as suggested by the Examiner, would not have been obvious.

For example, the Czyszczewski et al. patent states that "[t]he teachings found herein provide a cost effective multifunction device, as the multifunction controller and the scanner can be added to existing printers to create the multifunction device" (col. 2, lines 19-22). More specifically, the Czyszczewski et al. patent discloses that "[t]he scanner 20 and printer 43 may be any commercially available devices using industry standard interfaces for communication to the controller 25," whereby "[t]his provides an advantage in that the controller 25 may be integrated with scanning and printing devices already in place" (col. 5, lines 40-44). Accordingly, by providing the multifunction device including the multifunction controller as a separate device, the Czyszczewski et al. patent states that "[t]he multifunction device is also more competitive than traditional devices, as it allows the best scanners and printers to be selected on their own merit, rather than being tied together in a monolithic device" (col. 2, lines 39-42). Incorporating the multifunction controller into the printer, as suggested by the Examiner, would "tie" the controller and the printer together, thereby preventing scanners and printers to be selected on their own merit.

The Czyszczewski et al. patent also states that "...the multifunction controller is preferably implemented as a general purpose system, such as a PC or a workstation" whereby "[t]he general purpose multifunction controller enables modularity and middleware integration" (col. 2, lines 9-15). In this regard, the Czyszczewski et al. patent states that

**Response under 37 C.F.R. 1.116**

Applicant: Travis J. Parry

Serial No.: 09/989,340

Filed: November 20, 2001

Docket No.: 10012807-1

Title: METHOD AND SYSTEM FOR DISTRIBUTING PRINT JOB

"[t]he modularity of the multifunction device provides a number of advantages, in that the device is more affordable, has greater investment protection, is scalable, and has greater reach and availability" (col. 1, line 66 - col. 2, line 2). Incorporating the multifunction controller into the printer, as suggested by the Examiner, would eliminate this modularity.

The Czyszczewski et al. patent further states that "[t]he teachings found herein also provide investment protection for the purchaser by allowing more advanced printers or scanners to replace older technology, without replacing the entire multifunction device" (col. 2, lines 30-33). More specifically, the Czyszczewski et al. patent discloses that "[a]n additional advantage is that, as the scanner 20 or printer 43 reaches the end of its useful life, or additional features become available, the scanner 20 or printer 43 may be replaced, without replacing other components of the overall system that comprises the multifunction device 10" (col. 5, lines 44-50). In this regard, the Czyszczewski et al. patent specifically discloses that the multifunction controller "allows the modular replacement of printers and scanners" (col. 3, lines 1-2). Incorporating the multifunction controller into the printer, as suggested by the Examiner, would eliminate this replacement aspect of the multifunction controller in that replacing the printer would also involve replacing the multifunction controller if the controller were integrated into the printer.

Accordingly, Applicant submits that modifying the Czyszczewski et al. patent in the manner suggested by the Examiner to incorporate the controller into the printer, therefore, is contrary to the teaching of the Czyszczewski et al. patent in that the Czyszczewski et al. patent actually teaches away from incorporating the controller into the printer. In addition, modifying the Czyszczewski et al. patent in the manner suggested by the Examiner to incorporate the controller into the printer would defeat the intended purpose of the Czyszczewski et al. patent in that the selection, modularity, and replacement aspects of the Czyszczewski et al. patent would be eliminated. Applicant, therefore, submits that there is no suggestion or motivation to make the proposed modification.

In view of the above, Applicant submits that independent claims 1, 11, 16, and 21, and the dependent claims depending therefrom, are each patentably distinct from the Czyszczewski and Chang references and, therefore, are each in a condition for allowance. Applicant, therefore, respectfully requests that the rejection of claims 1-17 and 19-21 under 35 U.S.C. 103(a) be reconsidered and withdrawn, and that claims 1-17 and 19-21 be allowed.

RECEIVED  
CENTRAL FAX CENTER

NOV 22 2006

## Response under 37 C.F.R. 1.116

Applicant: Travis J. Parry

Serial No.: 09/989,340

Filed: November 20, 2001

Docket No.: 10012807-1

Title: METHOD AND SYSTEM FOR DISTRIBUTING PRINT JOB

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-17 and 19-21 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Response should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

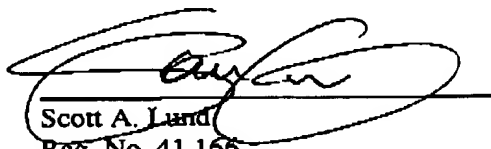
IP Administration  
Legal Department, M/S 35  
HEWLETT-PACKARD COMPANY  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400

Respectfully submitted,

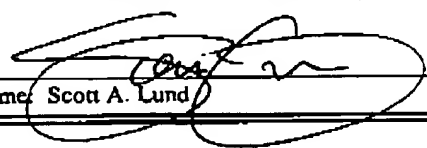
Travis J. Parry,

By,

DICKE, BILLIG & CZAJA, PLLC  
Fifth Street Towers, Suite 2250  
100 South Fifth Street  
Minneapolis, MN 55402  
Telephone: (612) 573-2006  
Facsimile: (612) 573-2005

Date: Nov. 22, 2006  
SAL:hsf  
Scott A. Lund  
Reg. No. 41,166

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300 on this 22<sup>nd</sup> day of November, 2006.

By   
Name: Scott A. Lund